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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,752	08/26/2005	Toshiyuki Aritake	2005-0935A	2026
513 7590 02/17/2009 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER KUGEL, TIMOTHY J				
ART UNIT		PAPER NUMBER		
1796				
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02/17/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/540,752

**Applicant(s)**

ARITAKE, TOSHIYUKI

**Examiner**

Timothy J. Kugel

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/22/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CI/CC)  
Paper No(s)/Mail Date 10/30/08, 12/22/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-9 are pending as amended on 22 December 2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Response to Amendment and Argument***

3. Applicant's amendment to claims 2 and 3, specifically, deleting the 'extra' parentheses, has overcome the following:

The rejection of claims 2-9 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

4. Applicant's terminal disclaimer has been fully considered and is proper.

The provisional rejection of claims 1-3, 5 and 7 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 4 of copending Application 10/565,532 has been withdrawn.

5. Applicant's argument, particularly that Japanese Patent Publication JP 2000-017163 (Fuji hereinafter) fails to teach a crystalline poly(lactic acid) polymer as instantly claimed, has been fully considered and is persuasive.

The rejection of claims 1, 2, 4 and 6 under 35 USC 102(b) as being anticipated by Japanese Patent Publication JP 2000-017163 (Fuji hereinafter) has been withdrawn.

The rejection of claims 3, 5 and 7-9 rejected under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over Fuji has been withdrawn.

6. Applicant's further argument has been fully considered but is not persuasive.

Applicant argues that low crystalline polylactic acid is used in the examples of JP 2002-155197 (Tanide hereinafter); however, Tanide clearly teaches the use of at least 20% and preferably more than 50% of high crystallinity poly(lactic acid) which meets the instant claims (Tanide 0012).

***Claim Rejections - 35 USC § 102 and/or 35 USC § 103***

7. Claims 1, 2, 4 and 6 stand rejected under 35 USC 102(b) as being anticipated by Japanese Patent Publication JP 2002-155197 (Tanide hereinafter). Tanide was cited as an X-type reference on the International Search Report for PCT/JP03/16642, from which the instant application is a national stage entry. Citations below come from a machine translation of Tanide, a copy of which is included with this action.

Tanide teaches a polylactic acid composition, sheet and articles formed from said sheet (¶0029), wherein said composition comprises 50-99.9 mass percent polylactic acid wherein polylactic acid of high crystallinity comprises at least 20% and preferably more than 50 mass percent and has an L-form to D-form ratio of not lower than 95:5

and not higher than 5:95 (Abstract and ¶0012) and wherein the polylactic acid may be copolymerized with other aliphatic polyester forming monomers—including hydroxybutyric acid as instantly exemplified (¶0009).

8. Claims 3, 5 and 7-9 stand under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over Tanide.

Tanide teaches a polylactic acid composition, sheet and articles formed from said sheet, wherein said composition comprises 50-99.9 mass percent polylactic acid wherein polylactic acid of high crystallinity comprises at least 20% and preferably more than 50 mass percent and has an L-form to D-form ratio of not lower than 95:5 and not higher than 5:95 and wherein the polylactic acid may be copolymerized with other aliphatic polyester forming monomers—including hydroxybutyric acid as instantly exemplified.

Pertaining specifically to claims 3, 6, 7 and 9, since Tanide teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the  $\Delta H_m$  and  $\Delta H_c$ —and therefore the relationships between the  $\Delta H_m$  and  $\Delta H_c$ —of the Tanide composition would inherently be the same as claimed. If there is any difference between the product of Tanide and the product of the instant claims the difference would have been minor and obvious.

Claims 5 and 7-9 are viewed as product-by-process claims and hence the methods they are created by are not pertinent, unless applicant can show a different product is produced. Even though product-by-process claims are limited by and defined

by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 USC 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 USC 103 and for anticipation under 35 USC 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached on 5:30 AM - 4:00 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy J. Kugel/  
Primary Examiner, Art Unit 1796